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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Jeal

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EXAMINER

HENNING, MATTHEW T

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,430	Applicant(s) JEAL ET AL.	
	Examiner MATTHEW T. HENNING	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/29/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1 This action is in response to the communication filed on 5/21/2009.

2 **DETAILED ACTION**

3 Applicant's arguments filed 5/21/2009 have been fully considered but they are not
4 persuasive.

5 The objection to the specification has been maintained due to the improper use of the
6 Trademarks BLUETOOTH and SMARTMEDIA. Each use of these trademarks should be
7 accompanied by the generic terminology where ever it appears.

8 Regarding the applicants' argument that Ohashi does not teach the newly claimed
9 limitations which requires that the authentication process for authenticating the transaction by
10 that user with the data processing apparatus not requiring use of the user's telecommunications
11 terminal, or authentication of the telecommunications terminal, the examiner does not find the
12 argument persuasive. While the new limitations have been addressed below, the examiner
13 provides the following brief explanation. Previously, the examiner had relied upon the client
14 terminal 12 as reading on both the data processing apparatus, and the user's telecommunications
15 terminal. However, as Col. 11 Lines 30-33 disclose that while only one terminal 12 is shown in
16 figure 6, "in fact there may be a plurality of client terminals having the similar constitution as the
17 terminal 12 and connected via respective communications lines." As such, the examiner is now
18 relying upon one of the other client terminals as reading upon the "user's telecommunications
19 terminal" and the client terminal 12 as reading upon the data processing apparatus. Therefore,
20 the examiner does not find the argument persuasive.

1 All objections and rejections not set forth below have been withdrawn.

2 Claims 1-53 have been examined.

3 ***Specification***

4 The disclosure is objected to because of the following informalities:

5 The disclosure lacks section headings.

6 The use of the trademarks BLUETOOTH and SMARTMEDIA have been noted in this
7 application. It should be capitalized wherever it appears **and be accompanied by the generic**
8 **terminology.**

9 Although the use of trademarks is permissible in patent applications, the proprietary
10 nature of the marks should be respected and every effort made to prevent their use in any manner
11 which might adversely affect their validity as trademarks.

12 Appropriate correction is required.

13 The examiner encourages the applicants to carefully check the specification to ensure that
14 no other trademarks have been used without proper capitalization and accompaniment by the
15 generic terminology.

16 ***Claim Rejections - 35 USC § 102***

17 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
18 basis for the rejections under this section made in this Office action:

19 *A person shall be entitled to a patent unless –*

20 *(b) the invention was patented or described in a printed publication in this or a foreign*
21 *country or in public use or on sale in this country, more than one year prior to the date of*
22 *application for patent in the United States.*
23

1 Claims 1-3, 5, 14-17, 19-23, 25, 34-38, and 41-43 are rejected under 35 U.S.C. 102(b) as
2 being anticipated by Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as
3 Ohashi.

4 Regarding claims 1, 21, and 42, Ohashi disclosed a device (card reader 11) for
5 connection to a data processing apparatus (client terminal 12), the device (card reader 11)
6 including authentication storage means (smart card 10) operatively coupled thereto for storing
7 predetermined authentication information respective to a user (Ohashi Col. 12 Lines 1-29), the
8 authentication storage means (smart card 10) being registered with a telecommunications system
9 (authentication center) which includes authenticating means (AuC data) and for which the user
10 has a telecommunications terminal (other client terminal; Col. 11 Lines 30-33), the device (card
11 reader 11), when operatively coupled to the authentication storage means (smart card 10), being
12 responsive to an input message for deriving a response dependent on the input message and on
13 the authentication information for enabling the authenticating means (AuC data) to carry out an
14 authentication process via a communication link (network 13) with the authenticating means
15 (AuC data) in the said telecommunications system (authentication center) whereby to
16 authenticate a subsequent transaction by the user with the data processing apparatus (client
17 terminal 12) (Ohashi Col. 12 Lines 1-29), and which involves use of the data carded by the
18 authentication storage means (smart card 10) (Ohashi Col. 12 Lines 1-29), the predetermined
19 authentication information stored by the authentication storage means (smart card 10)
20 corresponding to information which is used to authenticate the user registered with the
21 telecommunications system (authentication center) in relation to use of that users
22 telecommunications terminal in the telecommunications system (authentication center) (Ohashi

Col. 12 Lines 1-29), but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of the user's telecommunications terminal (Ohashi Col. 12 Lines 1-29) nor requiring the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications system (Ohashi Col 12 lines 1-29), and wherein the device controls access to the authentication information (Ohashi Fig. 6 wherein all communications in and out of the smartcard pass through the reader/writer).

Regarding claims 2 and 22, Ohashi disclosed security data entry means for obtaining security data independently of the data processing apparatus, and means for analyzing the entered security data for determining whether to allow access to the predetermined information (Ohashi Col. 12 Lines 1-29).

Regarding claims 3, and 23, Ohashi disclosed wherein the data entry means comprises alphanumeric data entry means (Ohashi Col. 12 Lines 1-29).

Regarding claims 5, 25, and 43, Ohashi disclosed that the security data comprises a Personal Identification Number (PIN) and the analyzing means compares the PIN obtained by the security data entry means with a PIN stored on the authentication storage means and only allows access to the predetermined information when the respective PINs match (Ohashi Col. 12 Lines 1-29).

Regarding claims 14 and 34, Ohashi disclosed that each user is authenticated in the telecommunications system by use of a subscriber identity module, and in which the authentication storage means respective to that user corresponds to or simulates the subscriber identity module (Smartcard) for that user (Ohashi Col. 12 Lines 1-29).

Regarding claims 15, and 35, Ohashi disclosed that the transaction is a transaction involving use of data processing functions of the data processing apparatus (Ohashi Col. 12 Lines 30-36).

Regarding claims 16, and 36, Ohashi disclosed that the authentication storage means is specific to that device (Ohashi Col. 11 Lines 65-67).

Regarding claims 17, and 38, Ohashi disclosed that the authentication process involves the sending of a message and the generation of a response dependent on the message and the predetermined information (Ohashi Col. 12 Line 55 – Col. 13 Line 10).

Regarding claims 19 and 20, see Ohashi Fig. 1.

Regarding claim 37, Ohashi disclosed that the authentication storage means is associated with the data processing apparatus by being associated with data or software for use by that data processing apparatus (Ohashi Col. 12 Lines 1-29).

Regarding claim 41, Ohashi disclosed that the data processing apparatus is a personal computer (Ohashi Col. 5 Paragraph 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18, 39-40, 46-51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi.

1 Regarding claims 18, and 39-40, while Ohashi disclosed providing a network service,
2 Ohashi fails to disclose the system levying a charge for the service transaction. However, it was
3 well known in the art of service providing to levy charges for providing the service. As such, it
4 would have been obvious to the ordinary person skilled in the art at the time of invention to have
5 had the system levy a charge for the service. This would have been obvious because the ordinary
6 person skilled in the art would have been motivated to provide the service provider with
7 compensation for the service.

8 Regarding claims 46, 49, and 53, while Ohashi disclosed the smart card communicating
9 with a smart card reader, Ohashi failed to disclose the communication being wireless. However,
10 it was well known at the time of invention for smart cards to communicate wirelessly. As such,
11 it would have been obvious to the ordinary person skilled in the art at the time of invention to
12 have provided the communications wirelessly. This would have been obvious because the
13 ordinary person skilled in the art would have been motivated to increase the ease of use for the
14 user.

15 Regarding claim 47, 48, 50 and 51, while Ohashi disclosed the smart card operable in a
16 general purpose personal computer and authenticating the computer for use in the system, Ohashi
17 failed to disclose that the computer could be a mobile computer. However, mobile computers,
18 such as laptops, pda's, and telephones were well known in the art at the time of invention. As
19 such, the ordinary person skilled in the art at the time of invention would have found it obvious
20 to modify Ohashi to include laptops, pda's telephones, and other such known mobile computers.
21 This would have been obvious because the ordinary person skilled in the art would have been
22 motivated to provide the user with more flexibility and ease of access.

1 Claims 4, 6-13, 24, 26-33, 44-45, and 52 are rejected under 35 U.S.C. 103(a) as being
2 unpatentable over Ohashi as applied to claims 1, 21, and 42 above, and further in view of Caputo
3 et al. (US Patent Number 5,778,071) hereinafter referred to as Caputo.

4 Regarding claims 4, 6, 24 and 26, while Ohashi disclosed a smart card reader, and entry
5 of PIN numbers, Ohashi failed to disclose the smart card reader having a keypad or a display.

6 Caputo teaches, in Fig. 1E and Col. 7 Lines 37-61, a smart card reader which has a
7 keypad and a display far facilitating the entry of PIN numbers.

8 It would have been obvious to the ordinary person skilled in the art at the time of
9 invention to have employed the teachings of Caputo in the smart card system of Ohashi by
10 utilizing the smart card reader of Caputo. This would have been obvious because the ordinary
11 person skilled in the art at the time of invention would have been motivated to provide a specific
12 means for the entry of PIN numbers, as generically suggested by Ohashi.

13 Regarding claims 7 and 27, Ohashi and Caputo taught a data processing module for
14 controlling the communication with the data processing apparatus (See Caputo Fig. 2 Element
15 172).

16 Regarding claims 8 and 28, Ohashi and Caputo taught that the data processing module of
17 the device is configured for communicating with a corresponding data processing module of the
18 data processing apparatus (Caputo Fig. 5A).

19 Regarding claims 9 and 29, Ohashi and Caputo taught that communication between the
20 authentication storage means and the data processing apparatus is performed via the respective
21 data processing modules (Caputo Fig. 2).

Regarding claims 10, 30 and 44, Ohashi and Caputo taught that the data processing module of the device includes means for decrypting encrypted data received from the data processing module of the data processing apparatus (Ohashi Col. 12 Lines 30-36 and Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Regarding claims 11, 31, and 45, Ohashi and Caputo taught the data processing module of the device includes means for encrypting data transmitted to the data processing module of the data processing apparatus (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Regarding claims 12, 32, and 52, Ohashi and Caputo taught that the respective data processing modules comprise a key for allowing encryption and/or decryption of data (Caputo Fig. 6).

Regarding claims 13, and 33, Ohashi and Caputo taught that the key comprises a shared secret key for each of the respective data processing modules (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Conclusion

Claims 1-53 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

1 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
2 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
3 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
4 however, will the statutory period for reply expire later than SIX MONTHS from the mailing
5 date of this final action.

6 Any inquiry concerning this communication or earlier communications from the
7 examiner should be directed to MATTHEW T. HENNING whose telephone number is
8 (571)272-3790. The examiner can normally be reached on M-F 8-4.

9 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
10 supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the
11 organization where this application or proceeding is assigned is 571-273-8300.

12 Information regarding the status of an application may be obtained from the Patent
13 Application Information Retrieval (PAIR) system. Status information for published applications
14 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
15 applications is available through Private PAIR only. For more information about the PAIR
16 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
17 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
18 like assistance from a USPTO Customer Service Representative or access to the automated
19 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

20
21 /Matthew T Henning/
22 Examiner, Art Unit 2431